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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/659,458

09/10/2003

Dean Jeffrey Schneider

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EXAMINER

KOEHLER, CHRISTOPHER M

ART UNIT

PAPER NUMBER

3726

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/659,458	Applicant(s) SCHNEIDER, DEAN JEFFREY	
	Examiner Christopher M. Koehler	Art Unit 3726	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 August 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 10 September 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>3/18/04</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

1. Applicant's election with traverse of in the reply filed on 8/8/2008 is acknowledged. The traversal is persuasive and the restriction is hereby withdrawn.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1-6, 10, 12 and 13 are rejected under 35 U.S.C. 102(b) as being anticipated by Bockenheimer (US Patent No. 5,937,486).

Claim 1:

Bockenheimer teaches a method of forming an assembly for a transportation vehicle, the method comprising: (a) providing a first component (20) of the transportation vehicle (col. 1, lines 15-20), the first component defining an opening (2); (b) providing a second component (30) of the transportation vehicle, the second component defining an opening (3); (c) providing a plastic annular member (5) extending between a first end and a second end, the plastic annular member having an inner surface (28) defining an open space; (d) applying an expandable polymeric material (5) upon at least one of the first component and the plastic annular member for forming a first seal (figure 8); (e) applying an expandable polymeric material (5) upon at least one of the second component and the plastic annular member for forming a second seal (Figure 8); and (f)

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expanding the first seal and the second seal (figure 8) such that: i) the first seal is adhered to a surface of the first component and a surface of the plastic annular member; and ii) the second seal is adhered to a surface of the second component and a surface of the plastic annular member (note that a seal is formed in both openings 2 and 3 by the expandable polymeric material). The recitation of a fuel fill assembly has not been given patentable weight because the recitation occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

Claim 2:

Bockenheimer teaches that the second component (30) is a body side inner panel of a vehicle (col. 1, lines 15-20).

Claims 3 and 6:

Bockenheimer teaches maintaining the position of the plastic annular member (5) relative to the first component (20) with one or more mechanical mating fasteners (25, 10) and assembling the first component to the vehicle prior to the step of expanding the first seal and the second seal, wherein the step of assembling the first component to the vehicle interconnects the opening (3) of the second component (30) with the open space (28).

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Claims 4 and 5:

Bockenheimer teaches that the first and second seals are annular (figure 8).

Claim 10:

Bockenheimer teaches that the expandable seal expands between about 50 and 350% (figure 8).

Claim 12:

Bockenheimer teaches that the annular member includes a first flange (26) and a second flange (10') bounding the first and second seals and the first and second components respectively.

Claim 13:

Bockenheimer teaches that the annular member is attached to the first and second components without any welds (figure 7).

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 7-9, 11 and 14-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bockenheimer.

Claims 7, 8 and 11:

Bockenheimer teaches the application of an expandable polymeric material but does not explicitly teach its composition. It would have been obvious to one of ordinary

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skill in the art at the time of the invention to have used an ethylene-based material that is fuel resistant, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416. The use of ethylene based expandable polymeric materials is known in the art as shown by Barz et al. (US Patent No. 6,383,610) at col. 3, lines 49-65. It would have been obvious to one of ordinary skill in the art at the time of invention to use an ethylene based material in the method of Bockenheimer since its silence on the exact composition to be utilized implies that any known composition would be suitable including ethylene-based materials.

Claim 9:

Bockenheimer teaches the invention cited with the exception of a two-step application. At the time of the invention, it would have been an obvious matter of design choice to a person of ordinary skill in the art, to have used a two-step application because applicant has not disclosed that such an application provides an advantage, is used for a particular purpose or solves a stated problem. One of ordinary skill in the art, furthermore, would have expected applicant's invention to perform equally well with either the integral molding application taught by Bockenheimer or the claimed two-step application because either application performs the same function of providing the expandable material equally well. Therefore, it would have been an obvious matter of design choice to modify Bockenheimer to obtain the invention specified in claim 9.

Claim 14:

Bockenheimer teaches a method of forming an assembly for a transportation vehicle, the method comprising: providing a first body side outer panel component (20) of the transportation vehicle (col. 1, lines 15-20), the first component defining an opening (2); providing a second component (30) of the transportation vehicle, the second component defining an opening (3); providing a plastic annular member (5) extending between a first end and a second end, the plastic annular member having an inner surface (28) defining an open space; applying an expandable polymeric material (5) upon at least one of the first component and the plastic annular member for forming a first seal (figure 8); applying an expandable polymeric material (5) upon at least one of the second component and the plastic annular member for forming a second seal (Figure 8); maintaining the position of the plastic annular member relative to the first component with mechanical fasteners (25, 10); and expanding the first seal and the second seal (figure 8) such that: the first seal is adhered to a surface of the first component and a surface of the plastic annular member; the second seal is adhered to a surface of the second component and a surface of the plastic annular member (note that a seal is formed in both openings 2 and 3 by the expandable polymeric material); and the open space (28) is interconnected with the openings of the components (figure 8).

Bockenheimer teaches that the components are automotive body panels, however, the invention is capable of broader application and could be incorporated in a variety of components but does not specifically teach that the second component is a wheelhouse. Since a wheelhouse is one of a variety of automotive body components it

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would have been obvious to one of ordinary skill in the art at the time of the invention to apply the method of Bockenheimer thereto as one of the variety of components in which Bockenheimer envisioned broader application of his method.

The recitation of a fuel fill assembly has not been given patentable weight because the recitation occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

Claims 15-22:

See the rejections of claims 6-13 above.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher M. Koehler whose telephone number is (571)272-3560. The examiner can normally be reached on Mon.-Fri. 7:30A-4:00P.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David P. Bryant can be reached on (571) 272-4526. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/C. M. K./
Examiner, Art Unit 3726

/DAVID P. BRYANT/
Supervisory Patent Examiner, Art Unit 3726